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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,632	01/27/2000	Ernst-Michael Hamann	GE998-005	1119

7590 03/29/2004
IBM Corporation
Anne Vachon Dougherty Esq
3173 Cedar Road
Yorktown, NY 10598

EXAMINER

ZIA, SYED

ART UNIT PAPER NUMBER

2131

8

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,632

Applicant(s)

HAMANN ET AL.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to arguments filed on January 30, 2004 (Paper No. 7). Original application contained Claims 1-15. Applicant amended Claims 1, 2, 4, 9, 11, and 12. The amendment filed have been entered and made of record. Presently pending claims are 1-15.

Response to Arguments

1. Applicant's arguments filed on January 30, 2004 (Paper No. 7) have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1-15 applicants argued that the cited prior art (CPA) [Gibbs et al. U.S. Patent No. 6,085,321] does not teach, "*that the signature component has any additional information provided therewith*", and CPA "*does not provide a signature device or method whereby the device includes both the signature program and all necessary information for creating and authenticating a digital signature*".

This is not found persuasive. CPA clearly teaches method of unique digital signature that comprises a service id for identifying user associated with an electronic messaging system and an

adapted digital signature, which is created with an index number and a system key using one-way hash function. The adapted digital signature is successfully authenticated only of preset or fixed number of times. The system key is private to electronic messaging system. The service id and adapted signature are concatenated to form unique digital signature. Unique digital signature has also system key to identify system key used to create adapted digital signature. The system key corresponds to service id and a domain name is also included. Thus, unsolicited, undesired electronic messages could be controlled using unique digital signature, and access to electronic service such as electronic media is provided on element-by-element basis rather than on fixed period subscription basis.

As a result, C PA does implement and teaches a system and method for managing, delivering, and enhancing digital signature in network environment.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that APA does teach or suggest the subject matter broadly recited in independent Claims 1, 9, 11-12, 18 and in subsequent dependent Claims 2-8, 10, and 13-15. Accordingly, rejections for claims 1-15 are respectfully.

Drawings

2. The drawings are objected to by the draftsperson (Office Action dated October 30, 2003 (Paper No.7)). A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The examiner suggests the Applicant's to remove the TITLE of the invention from the Abstract on page 23 accordingly.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Gibbs et al. U.S. Patent No. 6,085,321 ('Gibbs' hereinafter).

6. With respect to claim 1, Gibbs teach a method for generating a digital signature in a signature device having a signature program and certificate with signature key stored thereon and

certificate with signature key stored thereon for the signing of documents (see col. 2, lines 10-26), comprising of:

receiving input information to said signature device (see col. 3, lines 40-49);

executing said signature program by the steps of: creating a signature data set comprising at least the received information and a document extract value of the document for signing (see col. 2, lines 27-24); and

creating an expanded digital signature by encrypting the signature data set with the aid of a signature key stored in said certificate (see col. 3, lines 10-30; col. 8, lines 1-9).

7. As per claim 2, wherein said receiving input information comprises procuring the value of a signature counter from said signature device (see col. 3, lines 55-62; col. 4, lines 52-55).

8 Claim 3 rejected as above in rejecting claim 2, further comprising, prior to said procuring, creating the signature counter as an attribute of the signature key (see col. 3, lines 55-62; col. 7, lines 37-55; col. 8, lines 30-37).

9. Claim 4 rejected as above in rejecting claim 1, wherein the receiving input information comprises procuring an identifying characteristic to identify the signature device from said signature device (see col. 3, lines 31-49).

10. Claim 5 rejected as above in rejecting claim 4, wherein the receiving input information comprises procuring information as to the hardware and software environment used in creating the digital signature (see col. 6, lines 26-29).

11. Claim 6 rejected as above in rejecting claim 1, further comprising entering an identifying characteristic to identify the holder of the signature key prior to said receiving input information (see col. 8, lines 30-65).

12. Claim 7 rejected as above in rejecting claim 6, further comprising creating the identifying characteristic to identify the holder of the signature key as an attribute of the signature key (see col. 8, lines 30-65).

13. Claim 8 rejected as above in rejecting claim 7, further comprising changing the identifying characteristic to identify the holder of the signature key prior to said receiving (see col. 8, lines 30-65).

14. With respect to claim 9, a self-authenticating electronic signature device (see col. 5, lines 10-27) comprising:

a receiver for receiving input information (see col. 12, lines 42-47; col. 14, lines 27-33);

a data processor component for creating a signature data set comprising at least the received information and a document extract value of the document for signing (see col. 5, lines 10-42); and

an encryption component for creating an expanded digital signature by encrypting the signature data set with the aid of a signature key (see col. 3, lines 10-30; col. 8, lines 1-9).

15. Claim 10 rejected as above in rejecting claim 9, wherein the device is a chipcard (see col. 10, lines 63-67 to col. 11, lines 1-16).

16. With respect to claim 11, a program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform method steps for generating a digital signature in a signature device having a signature program and certificate with signature key stored thereon (see col. 10, lines 63-67 to col. 11, lines 1-7), said method steps comprising:

receiving input information to said information device (see col. 3, lines 40-49);

executing said signature program by the steps of creating a signature data set comprising at least the received information and a document extract value of the document for signing (see col. 5, lines 10-42); and

creating an expanded digital signature by encrypting the signature data set with the aid of a signature key stored in said certificate (see col. 3, lines 10-30).

17. With respect to claim 12, and improved digital signature, wherein the improvement comprises the inclusion of additional information generated by a self-authenticating signature device having signature certificate information stored with a signature program in addition to a document extract value of a document for signing (see col. 2, lines 27-34).

18. Claim 13 rejected as above in rejecting claim 12, wherein the additional information comprises information which uniquely identifies it in relation to every other digital signature generated with the same signature key (see col. 8, lines 38-55, 66-67 to col. 9, lines 1-9).

19. Claim 14 rejected as above in rejecting claim 12, wherein the additional information comprises information as to the signature device with which the digital signature was executed (see col. 8, lines 38-55, 66-67 to col. 9, lines 1-9).

20. Claim 15 rejected as above in rejecting claim 12, wherein the additional information comprises information on the hardware and software environment used in generating the signature (see col. 6, lines 26-29).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ
March 25, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100